REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1, 5, 6, 8, 9, 13, 14, 16, 17, 21, 22 and 24 have been amended. Claims 1-24 are pending. Antecedent basis for the amendments is located throughout Applicant's specification and the original claims, as for example in connection with the discussion of Figs. 1, 3b, 3l-3q, 4, 6 and 7a-7d. No new matter has been added.

Substitute Title

Applicant respectfully asks the Examiner to formally accept the substitute title.

Rejection of the claims

As suggested by the Examiner, Claims 5 and 6 have been amended.

In the Office Action mailed April 5, 2005, claims 1, 9 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0200507 ("Stern") in view of U.S. Patent No. 6,763,496 ("Hennings").

As amended, claim 1 recites:

> 1. A method performed by a computer system, comprising:
> storing a version of a hardcopy paper, the version being displayable on a display device as a likeness of the paper, wherein the paper is at least one of the following: a newspaper; and a magazine;
> in response to displayable content of the likeness, detecting a reference at a first location within the displayable content of the likeness, the detected reference being associated with a second location, and wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase; and
> in response to the detected reference, embedding a hyperlink within the version between the first location and the second location, and the first location being: displayable on the display device as part of the likeness; highlighted to indicate the hyperlink; and selectable by a user to cause an operation associated with the second location.

This application claims priority to Applicant's U.S. Provisional Patent Application No. 60/208,015, filed ***May 26, 2000***, entitled SYSTEM AND METHOD FOR PREPARING

PRINTED MATTER FOR DELIVERY TO PERSONAL COMPUTERS, naming Billy P. Taylor as inventor. Antecedent basis for claim 1 is located throughout Applicant's provisional patent application, as for example in connection with the discussion at pages 12-15 of Applicant's provisional patent application. By comparison, Stern's corresponding provisional patent application was subsequently filed ***June 16, 2000***. Thus, in relation to claim 1, Stern is not a prior art reference.

Moreover, Hennings fails to teach the combination of elements in amended claim 1, and Hennings also fails to teach, or even suggest, any basis for combining in a 35 U.S.C. § 103 rejection. MPEP § 2143.01 states: "The mere fact that references can be combined or modified does ***not*** render the resultant combination obvious unless the prior art also suggests the desirability of the combination." As stated in MPEP § 2142, "...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness..."

MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

In relation to amended claim 1, the motivation for advantageously combining the claimed elements would arise solely from hindsight based on Applicant's teachings in its own specification. Accordingly, the PTO's burden of factually supporting a prima facie case of obviousness has not been met.

Thus, in view of the reasons stated herein, and for other reasons clearly apparent, the PTO has not met its burden of factually supporting a prima facie conclusion of obviousness in this case, and Applicant has no obligation to submit evidence of nonobviousness.

In relation to claims 9 and 17, Stern and Hennings are likewise defective in establishing a prima facie case of obviousness.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 9 and 17.

Dependent claims 2-8 depend from and further limit claim 1 and therefore are allowable.

Dependent claims 10-16 depend from and further limit claim 9 and therefore are allowable.

Dependent claims 18-24 depend from and further limit claim 17 and therefore are allowable.

An early formal notice of allowance of claims 1-24 is requested.

To the extent that this Accompanying Amendment results in additional fees, the Commissioner is authorized to charge deposit account no. 50-3524.

Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,

Michael A. Davis, Jr.
Registration No. 35,488

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below:

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Michael A. Davis, Jr.
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Date: July 5, 2005
Davis Law Group, P.C.
9020 N. Capital of Texas Hwy.
Bldg. 1, Suite 375
Austin, Texas 78759
Telephone 512-306-8324
Facsimile 512-306-8374
Docket Number: 1005.11